

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of

ECHEVERRI

Atty. Ref.: 2590-146

Serial No. 10565002 (Conf. No. 5148)

TC/A.U.: 3775

Filed: January 19, 2006

Examiner: Andrew Yang

For: ORIENTATION DEVICE FOR SURGICAL IMPLANT

May 12, 2010

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Applicant appeals to the Board of Patent Appeals and Interferences from the final rejection of the Examiner.

Applicant petitions for a one month extension to file this Brief, up to and including May 12, 2010.

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

(I) REAL PARTY IN INTEREST

The real party in interest is SAN-TECH SURGICAL SARL.

(II) STATEMENT OF RELATED CASES

The applicant and the undersigned are not aware of any related appeals, interferences, or judicial proceedings (past or present), which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

(III) STATUS OF CLAIMS

Claim 1 stands rejected. Dependent claims 2-12 have been cancelled without prejudice with the right to re-present them upon allowance of amended claim 1 that is being appealed.

Claim 13 has been cancelled without prejudice; it's subject matter is now contained in claim 1.

(IV) STATUS OF AMENDMENTS

On August 10, 2009, the Examiner mailed a Final Office Action that rejected claims 1-13.

On January 11, 2009, applicant filed an Amendment After Final that inserted the subject matter from dependent claim 13 into claim 1 and cancelled claim 13 without prejudice.

On February 3, 2010, the Examiner mailed an Advisory Action that surprisingly refused to enter the Amendment – which was simple and straightforward.

On February 12, 2010, applicant was then forced to file another Amendment After Final that once again amended claim 1 to incorporate the subject matter from claim 13, and cancelled claim 13 without prejudice. Because of the Examiner's first Advisory Action position, the Amendment also noted that dependent claims 2-12 were being cancelled without prejudice with the right to re-present them upon allowance of amended claim 1 that is being appealed.

On February 12, 2010, applicant also filed a Notice of Appeal.

On March 4, 2010, the Examiner issued an Advisory Action that entered the Amendment of February 12, 2010, and continued to reject the application on prior art grounds.

In summary, the claim amendments and reservations of February 12, 2010, have been entered as follows:

- claim 1 has been amended to incorporate the subject matter from claim 13,
- claim 13 has been cancelled without prejudice, and
- dependent claims 2-12 have been cancelled without prejudice with the right to re-present them upon allowance of amended claim 1 that is being appealed.

(V) SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is summarized best by reading claim 1, which is the only independent claim in this application and is the only claim on appeal. Claim 1 can be parsed and cited for support as follows:

1. A guide for an acetabular prosthetic cup instrument (page 8, lines 33-34; Fig 1A, ref 2), said guide comprising:

a shaft (page 8, line 35; Fig 9 no. 8),
instrument fixing means (page 3, line 7; page 8, lines 33-34; Fig 1A no. 11) for fixing said guide to a surgical instrument (page 8, line 34; Fig 5 no. 4; Fig 6 no. 37), and
a frame (page 8, line 33; Fig 1A no. 35) situated between said shaft and said instrument fixing means,

wherein said guide for an acetabular prosthetic cup instrument further comprises:

pointing means (page 9, line 3, Fig 1A no.12; page 9, line 5, Fig 1B no. 38) situated at the shaft distal end, and

orientation means (page 8, lines 35-36; Fig 1A, no. 6; Fig 6, no. 6; Fig 9, nos. 9, 10), distinct from the shaft, which are adapted to define a reference plane (page 3, line 14), and wherein the orientation means are a dual-axis type (page 3, line 14; Fig 9, nos. 9, 10).

For the means-plus-function elements, applicant notes the following information.

- Instrument fixing means for fixing said guide to a surgical instrument. These are exemplified in the application as implements - page 3, line 7; page 8, lines 33-34; Fig 1A no. 11; Fig 9 no. 36.

- Pointing means situated at the shaft distal end. These are exemplified in the application as a shaft with a free distal end adapted to aim at a reference point – page 3, lines 28-29; laser pointer – page 7, line 9, page 9, line 5, Fig 1B no. 38; and pointers – page 9, line 3, Fig 1A no.12; page 9, line 5, Fig 1B no. 38.
- Orientation means, distinct from the shaft, which are adapted to define a reference plane, and wherein the orientation means are a dual-axis type. These are exemplified in the application as electronic, bubble, or fluid type – page 4, lines 9-13, Fig 1A, no. 6; Fig 6, no. 6; Fig 9, nos. 9, 10; bubble levels – page 8, lines 33-36, Fig 1A, no. 6; Fig 6, no. 6; Fig 9, nos. 9, 10; and indicators – page 9, line 25, Fig 1A, no. 6; Fig 6, no. 6; Fig 9, nos. 9, 10.

(VI) GROUND OF REJECTION TO BE REVIEWED

1. Is amended claim 1 (effectively claim 13 in the Final Office Action rejection) properly rejected under 35 USC 102(e) as being anticipated by Subba Rao (USP 6743235).

(VII) ARGUMENT

As noted above, claim 1 was amended to incorporate the subject matter from claim 13 (wherein the orientation means are a dual-axis type), and claim 13 was cancelled without prejudice. Dependent claims 2-12, which depend directly or indirectly from claim 1, were cancelled without prejudice with the right to re-present them upon allowance of amended claim 1 that is being appealed.

The incorporation of the claim 13 subject matter into claim 1 renders moot all of the rejections in the Final Office Action with the sole exception of the rejection of claim 13 on page 3 of the Final Office Action, i.e., where claims 1, 3, 7, 8, and 13 stand rejected as allegedly being anticipated by Subba Rao (USP 6743235).

Applicant requests reversal of the anticipation rejection of amended claim 1 for at least the following reasons:

- i) the rejection is based on incorrect technical statements or assumptions, and
- ii) Rao does not disclose each and every element of the claim, e.g., the claimed “dual-axis type” orientation means, and the claimed “orientation means, distinct from the shaft, which are adapted to define a reference plane.”

The claimed invention requires a dual-axis type orientation means. Rao is limited to and expressly teaches the use of a single-axis type orientation means (bubble level 40), as those of skill in the art readily know and understand. Thus, Rao does not anticipate the claimed invention.

Rao actually teaches away from the claimed invention by unequivocally teaching the use of single-axis type orientation means (bubble level 40). A thorough reading and understanding of Rao confirms that Rao has no desire or contemplation to use a dual-axis type orientation as claimed by applicant and understood to those of skill in the art. The Final Rejection erroneously

contends that Rao's device has a dual axis type orientation means by citing to Rao's bubble level 40 and an orientation pillar, but no person skilled in the art would consider this a dual-axis type orientation means, and there is no evidence of record in support of the contention.

As one skilled in the art can see and understand from the Rao figures, the Rao orientation means simply comprises a single bubble level 40 that is designed for orienting the device along a single direction that Rao repeatedly calls alignment. With this Rao device, even when the bubble is located at the right place (i.e., between the two marking lines in bubble level 40), there are an infinite number of possibilities to move the device (for example, rotate the device) while maintaining the bubble at the right place. This is clearly the intent of Rao; consequently, Rao does not have a second bubble level and does not need a second bubble level. This is not the case with the claimed device that requires a dual-axis type orientation means.

One dual-axis embodiment of the claimed invention is illustrated in Figure 1A of the subject application. The device includes two bubble levels (reference numbers 9 and 10). Using a dual-axis type orientation means, e.g., two bubble levels instead of one bubble level, allows a surgeon to position the claimed device in one unambiguous single position. Rao does not disclose, contemplate, or even remotely suggest this critical feature and its objective.

The claimed device is specifically positioned thanks to the dual-axis type orientation means while in the Rao reference the orientation means are not sufficient to position the device as contemplated by the claimed invention. Instead, further input from the surgeon is required by the Rao device.

Applicant also notes that the claimed guide for an acetabular prosthetic cup instrument comprises an orientation means, distinct from the shaft, which are adapted to define a reference plane, and wherein the orientation means are of the dual-axis type. All of these

features are significant and clearly distinguish over Rao. The claimed features define a reference plane. The applicant's device requires at least two axes (or one axis and one point) in order to define a reference plane. In contrast, if there is only one axis as in Rao, then no reference plane can be defined but, instead, an infinite number exist. Rao does not appreciate or even attempt to define a single reference plane.

For at least the foregoing reasons, applicant respectfully requests the reversal of the anticipation rejection based on Rao.

CONCLUSION

Applicant respectfully requests the Board to reverse the final rejection and pass the subject application to allowance and permit applicant to re-present dependent claims 2-12 that depend directly or indirectly from claim 1. Claims 2-12 were not rejected on formalistic grounds. If independent claim 1 is allowable over the cited art, then certainly its dependent claims are allowable over the cited art.

Respectfully submitted,

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(VIII) **CLAIMS APPENDIX**

1. (rejected) A guide for an acetabular prosthetic cup instrument, said guide comprising:

a shaft,

instrument fixing means for fixing said guide to a surgical instrument, and

a frame situated between said shaft and said instrument fixing means,

wherein said guide for an acetabular prosthetic cup instrument further comprises:

pointing means situated at the shaft distal end, and

orientation means, distinct from the shaft, which are adapted to define a reference plane,

and wherein the orientation means are a dual-axis type.

2. (cancelled) A guide according to claim 1 wherein said pointing means comprise a pair of parallel shafts which are oriented at an angle with respect to the shaft direction.

3. (cancelled) A guide according to claim 1 wherein said pointing means comprise a laser beam.

4. (cancelled) A guide according to claim 1 wherein said orientation means are adjustable.

5. (cancelled) A guide according to claim 4 wherein said orientation means comprise two bubble levels.

6. (cancelled) A guide according to claim 5 wherein, the first bubble level is adapted for orientating an instrument fixed to said guide with respect to a right hip and wherein the second bubble level is adapted for orientating said instrument with respect to a left hip.

7. (cancelled) A guide according to claim 1 wherein said instrument fixing means are adapted to allow a quick fixation or release of the guide to/from the instrument.

8. (cancelled) A combination of a guide according to claim 1 together with an acetabular prosthetic cup instrument comprising a shaft and with a handle at its proximal end and with a distal end adapted for receiving either a reamer or a cup positioner.

9. (cancelled) A combination of a guide according to claim 1 together with a pelvic positioner, said pelvic positioner comprising two arms with respective feelers and orientation means.

10. (cancelled) A combination of a guide according to claim 1 together with a pelvic orientation witness, said pelvic orientation witness comprising pelvic fixing means for fixing said pelvic orientation witness to the pelvis and orientation means.

11. (cancelled) A combination of a guide according to claim 1 together with an angle measuring device for measuring the angle between ASIS (Anterior Superior Iliac Spine) and HJC (Hip Joint Center).

12. (cancelled) A calibrating apparatus for calibrating a guide and an instrument as defined in claim 1, said calibrating apparatus comprising angle reproducing means for reproducing the angle between ASIS and HJC.

13. (cancelled).

(IX) EVIDENCE APPENDIX

Not Applicable.

(X) **RELATED PROCEEDINGS APPENDIX**

Not Applicable.